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10/665,733

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EXAMINER

SHAIKH, MOHAMMAD Z

ART UNIT

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3696

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/665,733 | Applicant(s) MITSUMOTO ET AL. | |
| | Examiner MOHAMMAD Z. SHAIKH | Art Unit 3696 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/5/04, 1/03/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is made **Non-Final** because examiner is making a new ground of rejection not necessitated by Applicant's amendment.

Priority

2. Examiner is withdrawing the statement regarding a priority date of 03/10/2001. The USPTO was indeed closed that day due to Hurricane Isabel.

Drawings

3. The objection is withdrawn for the drawings submitted on 6/18/04. The update drawings filed on 1/15/08, have been accepted.

Status of Claims

4. Claims 1-15 are pending in this application.

Claim Rejections- 35 U.S.C § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 11-13, 15 are being rejected under 35 U.S.C 102(b) as being anticipated by U.S Patent 6,321,213 to Ito et al, herein referred to as Ito.

Regarding claim 1, Ito discloses an electronic money remittance method for remitting electronic money from a first user to a storage means storing electronic money of a second user (column 3, lines 25-37), comprising: receiving predetermined remittance order information from a terminal for use by the first user (Fig 6: 2102, 2106); generating a program for depositing an electronic money amount equivalent to the remittance in the storage means of the second user based on the remittance order information, and subtracting the amount equivalent to the remittance from a predetermined account balance related to the first user ; transmitting the program to a terminal for use by the second user (column 8, lines 44-54); receiving a remittance instruction transmitted from the terminal for use by the second user as a consequence that the program received by the terminal for use by the second user is executed by said terminal (column 5, lines 48-61); depositing an electronic money amount equivalent to the remittance by accessing the storage means of the second user connected to the

terminal for use by the second user according to the remittance instruction, and adding the amount equivalent to the remittance to an electronic money management account balance related to the electronic money stored in the storage means of the second user (column 5: lines 58-66; column 6, lines 1-13).

Regarding claim 2, Ito discloses the electronic money remittance method according to claim 1, wherein the electronic money balance stored in the storage means of each user is managed in the electronic money management account either separately on a per storage means or collectively (column 1, lines 59-67; column 2, lines 27-43).

Regarding claim 3, Ito discloses the electronic money remittance method according to claim 1, wherein, an electronic money account due for remittance is opened (Fig 2:2102); the remittance amount subtracted from a predetermined account balance of the first user is transferred to the electronic money account due for remittance (column 8, lines 44-54) ; and according to the remittance instruction, the remittance is transferred from the electronic money account due for remittance to the electronic money management account (column 5: lines 58-66; column 6, lines 1-13).

Regarding claim 4, Ito discloses the electronic money remittance method according to claim 1, wherein, the electronic money remittance method according to claim 1, wherein, when the first user owns a storage means storing electronic money, an electronic money amount equivalent to the remittance is subtracted from the electronic money management account balance related to the

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electronic money stored in said storage means of the first user; and further, the storage means of the first user connected to the terminal for use by the first user is accessed, and an electronic money amount equivalent to the remittance is paid out from said storage means (column 4, lines 59-64).

Claim 11 is being rejected using the same rationale as claim 1.

Claim 12 is being rejected using the same rationale as claim 1.

Claim 13 is being rejected using the same rationale as claim 1.

Regarding claim 15, Ito discloses a terminal for use by a second user, performing a processing for electronic money remittance from a first user to a storage means of the second user (column 3, lines 25-37), comprising: a communication section which receives, from an electronic money server managing electronic money of each user, a program for depositing an electronic money amount equivalent to the remittance into the storage means of the second user (column 5, lines 48-61); and an execution section which executes the program, wherein, by executing the program by the execution section, the communication section enables the electronic money server to access the storage means of the second user connected to the terminal, and deposit the electronic money amount equivalent to the remittance, and the communication section transmits, to the electronic money server through a network, a remittance instruction for adding the amount equivalent to the remittance to an electronic money management account balance related to the electronic money in the storage means of the second user (column 5, lines 58-66; column 6, lines 1-3).

Claim Rejections- 35 U.S.C § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6-8 are being rejected under 35 U.S.C 103(a) as being unpatentable over Ito in view of US 2001/0027435 to Asano et al, herein referred to as Asano.

Regarding claim 6, Ito discloses the electronic money remittance method according to claim 1. However Ito does not disclose wherein the storage means is an IC card. Asano discloses wherein the storage means is an IC card (paragraphs: 0032, 0033). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include the storage means an IC card. One of ordinary skill in the art would have been motivated to include the storage means as an IC card in order to ensure that the users have the ability to transfer money by all different means.

Regarding claim 7, Ito discloses the electronic money remittance method according to claim 6. However Ito does not disclose wherein the remittance order information includes identification information of the IC card of the second user, and the remittance amount. Asano discloses wherein the remittance order information includes

identification information of the IC card of the second user, and the remittance amount (paragraphs: 0037, 0043). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include wherein the remittance order information includes identification information of the IC card of the second user, and the remittance amount. One of ordinary skill in the art would have been motivated to include remittance order information which includes identification information of the IC card of the second user, and the remittance amount in order to ensure that the entire remittance process runs efficiently.

Claim 8 is being rejected using the same rationale as claim 7.

10. Claims 9&10 are being rejected under 35 U.S.C 103(a) as being unpatentable over Ito in view of Asano and further in view of US 2001/0034725 to Park et al, herein referred to as Park.

Regarding claim 9, Ito discloses the electronic money remittance method according to claim 7. However Ito does not disclose wherein, the identification information of the IC card of the second user is an electronic-mail address of the second user; and the electronic money system includes a mapping table between the IC card number of each user and the electronic mail address, and obtains the IC card number of the second user based on said mapping table. Park discloses the identification information of the IC card of the second user is an electronic-mail address of the second User (paragraphs: 0021). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include wherein the

identification information of the IC card of the second user is an electronic-mail address of the second user. One of ordinary skill in the art would have been motivated to include wherein the identification information of the IC card of the second user is an electronic-mail address of the second user in order to ensure that the entire remittance process runs efficiently. Park discloses the electronic money system includes a mapping table between the IC card number of each user and the electronic mail address, and obtains the IC card number of the second user based on said mapping table (Figs: 1,2). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include a mapping table between the IC card number of each user and the electronic mail address, and obtains the IC card number of the second user based on said mapping table. One of ordinary skill in the art would have been motivated to include a mapping table between the IC card number of each user and the electronic mail address, and obtains the IC card number of the second user based on said mapping table in order to ensure that an accurate record is maintained for users.

Regarding claim 10, Ito discloses the electronic money remittance method according to claim 1. However Ito does not disclose wherein the program is attached to an electronic mail and transmitted for use by the second user. Park discloses the electronic money remittance method according to claim 1 (paragraph: 0044). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include a program that is attached to an electronic mail and transmitted for use by the second user. One of ordinary skill in the art would have been

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motivated to include a program that is attached to an electronic mail and transmitted for use by the second user in order to ensure that the entire remittance process runs efficiently.

11. Claim 5,14 is being rejected under 35 U.S.C 103(a) as being unpatentable over Ito in view of Park.

Regarding claim 5, Ito discloses the electronic money remittance method according to claim 1. However Ito does not disclose, wherein, when the first user does not own any storage means storing electronic money, an amount equivalent to the remittance is subtracted from a bank account balance of the first user. Park discloses when the first user does not own any storage means storing electronic money, an amount equivalent to the remittance is subtracted from a bank account balance of the first user (paragraphs: 0005; claim 3). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include a feature, when the first user does not own any storage means storing electronic money, an amount equivalent to the remittance is subtracted from a bank account balance of the first user. One of ordinary skill in the art would have been motivated to include a feature, when the first user does not own any storage means storing electronic money, an amount equivalent to the remittance is subtracted from a bank account balance of the first user in order to ensure that the entire remittance process runs efficiently

Regarding claim 14, Ito discloses a terminal for use by a first user, performing a processing for electronic money remittance from the first user to a storage means of a

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second user (column 3, lines 25-37). However Ito does not disclose a display-unit which displays a remittance order information generation screen for remitting electronic money; and a communication section which transmits through a network the remittance order information generated according to the remittance order information generation screen to-an electronic money server managing electronic money of each user. Park discloses a display-unit which displays a remittance order information generation screen for remitting electronic money (paragraph: 0041); and a communication section which transmits through a network the remittance order information generated according to the remittance order information generation screen to-an electronic money server managing electronic money of each user (paragraphs: 0043,0044). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ito's invention to include a display-unit which displays a remittance order information generation screen for remitting electronic money; and a communication section which transmits through a network the remittance order information generated according to the remittance order information generation screen to-an electronic money server managing electronic money of each user. One of ordinary skill in the art would have been motivated to include a display-unit which displays a remittance order information generation screen for remitting electronic money; and a communication section which transmits through a network the remittance order information generated according to the remittance order information generation screen to-an electronic money server managing electronic money of each user in order to ensure that the entire remittance process runs efficiently.

Response to Remarks

12. Applicant's arguments, filed on 1/15/2008, with respect to the rejections of claims 1,3-7,10-13,15 under 35 U.S.C 102(b) and claims 2,8-9,14 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S Patent 6,321,213 to Ito et al, and US 2001/0034725 to Park et al, and further in view of US 2001/0027435 to Asano et al.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD Z. SHAIKH whose telephone number is (571)270-3444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Z. S./
Examiner, Art Unit 3696
2/29/2008

Mohammad Z Shaikh
Examiner
Art Unit 3696

/Daniel S Felten/
Primary Examiner, Art Unit 3696